

REMARKS

Claims 1-40 and 42-118 are pending in the Application. By this amendment, claims 1, 6, 14, 16-18, 21-23, 25-27, 30-32 and 92 are amended and new claims 95-118 are added. Applicants note that dependent claims 6 and 27 were amended to delete the word "fixed" and claim 23 was amended to replace the word "restricting" with "establishing" in order to more broadly claim Applicants' invention.

In the outstanding Office Action, the Examiner rejected claims 1-40¹ and 42-94² under 35 U.S.C. § 103(a) as being unpatentable over O'Neil et al. (U.S. Pat. No. 5,987,440) in view of Goldhaber et al. (U.S. Pat. No. 5,855,008).

Based on the following remarks, Applicants submit that the pending claims are allowable over O'Neil et al. and Goldhaber et al., taken either alone or in combination.

1. Independent claim 42

The Examiner did not address the arguments presented with respect to claim 42 in Section 3 of the Amendment filed August 25, 2003. Rather, the Examiner indicated that "Applicant's arguments with respect to [then pending] claims 1-94 have been considered but are moot in view of the new grounds of rejection." However, in the outstanding Office Action, claim 42 is rejected on the same grounds advanced in the

¹ Claim 41 was cancelled by the Amendment filed August 25, 2003. Accordingly, Applicants believe the listing of claim 41 in the statement of the rejection on page 2 of the outstanding Office Action to be a typographical error.

² Claim 47 is not mentioned in the statement of the rejection on page 4 of the outstanding Office Action, but is mentioned in the body of the rejection, on page 6 of the Office Action. Accordingly, Applicants believe the omission of claim 47 from the statement of the rejection to be a typographical error and treat it as being rejected on the same grounds.

prior Office Action, i.e., as being unpatentable over O'Neil et al. in view of Goldhaber et al. Moreover, the rejection itself does not address the deficiencies pointed out in the previous arguments. In fact, the outstanding rejection of claim 42 fails to address the recitation, "one of the set of payment rules includes paying the user for purchasing a product or service from one of the subscribers," which was previously urged as distinguishing the claim from O'Neil et al. in view of Goldhaber et al.

Accordingly, Applicants' previous arguments with respect to claim 42 remain applicable and, without an indication of the Examiner's position regarding these arguments, Applicants are unable to make an informed decision regarding the prosecution of this claim. Therefore, Applicant incorporates by reference the arguments presented in Section 3 of the response filed August 25, 2003 and respectfully requests that the Examiner address these arguments in a supplemental Office Action or allow the claim.

Also, Applicants point out that claim 42 does not require that the consumer information be provided in response to an incentive offered to a user. Accordingly, that O'Neil et al. does not specifically teach such feature (as pointed out in the rejection of this claim) is irrelevant with respect to claim 42.

2. Independent claims 1, 14, 23, 32, 43, 44, 89 and 92

Claims 1, 14, 23 and 32 are amended to recite, "the licensing fee schedule is one of: (a) an increasing fee schedule, (b) a declining fee schedule and (c) a fee schedule that is based on the funds received from subscribers for licensing the personal information related to that user." Claims 43, 44, 89 and 92 similarly recite a declining fee schedule. Claims 43, 44 and 89 have not been amended; claim 92 has been

amended only to correct a minor informality. In the outstanding Office Action, the Examiner rejects claims reciting both increasing, declining and percentage fee schedules. Specifically, the Examiner rejects claims 9, 20, 29, 38, 43, 44, 89 and 92 (reciting a declining fee schedule); claims 64, 72, 80 and 88 (reciting an increasing fee schedule); and claims 6, 18, 27 and 36 (reciting a percentage fee schedule) as being unpatentable over O'Neil et al. and Goldhaber et al. However, Applicants submit that O'Neil et al. and Goldhaber et al., taken alone or in combination, do not teach any one of these fee schedules.

a. Increasing and declining fee schedules

In the rejection, the Examiner admits that neither O'Neil et al. nor Goldhaber et al. teach either an increasing fee schedule or declining fee schedule, but asserts that:

[T]hese differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The "offering an incentive" through "paying each of the users" steps would be performed the same regardless of what kind of fee schedule mechanism is employed. Thus this descriptive material will not distinguish the claimed invention from [O'Neil et al. and Goldhaber et al.]

In making this assertion, the Examiner relies on *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and *In re Lowry*, 32 USPQ.2d 1031 (Fed. Cir. 1994). However, the Examiner errs in applying these cases.

Gulack addresses "printed matter" rejections. Specifically, *Gulack* holds that "[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *Gulack*, 217

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USPQ at 404. The *Lowry* Court, however, rejected a previous attempt by the Office to apply the printed matter rejection in other contexts.

The printer matter cases[, e.g., *Gulack*,] dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind. The printed matter cases have no factual relevance where the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer.

Lowry, 32 USPQ.2d at 1034 (internal quotations and citation omitted). The present claims are drawn to systems, methods and computer readable medium, not printed lines and characters. Accordingly, Applicants submit that the cited printed matter cases are not relevant to Applicants' claimed invention.

The irrelevancy of the cited cases notwithstanding, Applicants submit that, contrary to the Examiner's position, the claim recitations at issue are indeed "functionally involved in the steps recited." Recitation that the fee schedule is declining or increasing functionally involves, for example: the licensing agent of claim 1, the recited setting steps of claims 14 and 23, and the recited means for setting of claim 32. Far from being "performed the same regardless of what kind of fee schedule mechanism is employed," as asserted by the Examiner, declining and increasing fee schedules are performed differently from other fee schedules and, by definition, performed differently from each other. Therefore, such recitations are to be given patentable weight; they are not mere markings on paper. Accordingly, Applicants submits that amended claims 1, 14, 23 and 32 as well as unamended claims 43, 44, 89 and 92 are allowable.

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Further, in the rejection of claims 9, 20, 29, 38, 43, 44, 64, 72, 80, 88, 89 and 92, the Examiner takes Official Notice that declining and increasing fee schedules were well known in the art at the time of the invention. Applicant respectfully traverses this Official Notice and requests that, if this position is maintained with respect to the pending claims, the Examiner either cite a competent prior art reference to substantiate such conclusion, or allow the claims.

Moreover, claims 43 and 44 recite, "the declining fee schedule is reset when a user updates their consumer information." Similarly, claims 89 and 92 recite that the "licensing fee paid to a user declines until detection of a predetermined user event." However, such recitations are neither addressed in the rejection, nor taught by O'Neil et al. or Goldhaber et al. As with the declining fee schedule itself, recitation of situations in which the fee is reset or stops declining is functionally involved with other recitations of the claims. Accordingly, the rejection of claims 43, 44, 89 and 92 is improper for at least these additional reasons, and Applicants thus request that the rejection be withdrawn and the claims allowed.

b. A fee schedule that is based on the funds received from subscribers for licensing the personal information related to that user

O'Neil et al. also fails to teach the final alternative fee schedule recited in claims 1, 14, 23 and 32, i.e., "a fee schedule that is based on the funds received from subscribers for licensing the personal information related to that user." In the outstanding rejections, the Examiner alleges that O'Neil et al. teaches an example of such a fee schedule, e.g., a fee schedule that is "a percentage of funds received from subscribers for licensing the personal information related to that user," as recited in

claims 6, 18, 27 and 36. However, O'Neil et al. teaches only fees of a fixed dollar amount, e.g., "a charge of \$1.00 per name and telephone number released, [to which] an individual could add a requirement that they receive \$0.25, too." O'Neil et al., col. 21, ll. 54-59. O'Neil et al. does not teach that such fees are "based on the funds received from subscribers for licensing the personal information related to that user," as recited in these claims. Nor does O'Neil et al. teach any of the other recited alternative fee schedules of claims 1, 14, 23 and 32. Moreover, Goldhaber et al. does not cure this deficiency of O'Neil et al. Accordingly, Applicants submit that amended claims 1, 14, 23 and 32 are allowable.

3. New claims 95-98

New claim 95 contains the recitations of claims 1 and 60, as they appeared prior to the current amendment; new claim 96 contains the recitations of claims 14 and 68, as they appeared prior to the current amendment; new claim 97 contains the recitations of claims 23 and 76, as they appeared prior to the current amendment; and new claim 98 contains the recitations of claims 32 and 84, as they appeared prior to the current amendment.

Claim 95 recites, "the user's response includes authorization to access information about the at least one potential user from a third party source of user information." Claims 96-98 include recitations similar to those in claim 95. Contrary to the Examiner's allegations (in the outstanding rejection of claim 60), Goldhaber et al., fails to teach such authorization, either in the cited portions thereof (col. 6, l. 66 – col. 7, l. 11; and col. 12, ll. 49-61) or anywhere else. Note, further, that "authorization to access information ... from a third party source," as recited in claims 95-98, differs in

scope from "the database ... includes user information from at least one third-party source," as recited in, e.g., claim 8. Moreover, O'Neil et al. is not relied upon to teach, and in fact does not teach, such authorization. Accordingly, for at least these additional reasons, claims 95-98 should be allowed.

4. Dependent claims 2-13, 15-22, 24-31, 33-40, 45-88, 90, 91, 93, 94 and 99-118

Claims 2-13, 15-22, 24-31, 33-40, 45-88, 90, 91, 93, 94 and 99-118 depend, directly or indirectly, from one of claims 1, 14, 23, 32, 42, 43, 89 and 92. Accordingly, these claims are allowable for at least the same reasons as argued with respect to claims 1, 14, 23, 32, 42, 43, 89 and 92 above, and Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

In addition, claims 6, 18, 27, 36 and 104 recite, "setting the licensing fee schedule such that a contributing user receives a percentage of funds received from subscribers for licensing the personal information related to that user." As argued above with respect to claims 1, 14, 23 and 32, O'Neil et al. teaches only fees of a fixed dollar amount. Further, Goldhaber et al. does not suggest the claimed fee schedule. Accordingly, for at least these additional reasons, the rejection of claims 6, 18, 27 and 36 should be withdrawn and the claims allowed.

Further, claims 114-118 depend from claims 6, 18, 27, 36 and 104, respectively, and recite that the percentage is a fixed percentage. Again, such a fee schedule is not taught by O'Neil et al. and Goldhaber et al., taken either alone or in combination.

Accordingly, for at least these additional reasons, the rejection of claims 114-118 should be withdrawn and the claims allowed.

Claims 9, 20, 29, 38, 43, 44, 64, 72, 80, 88, 89, 92 and 99-101 are drawn to declining or increasing fee schedules. As argued above, such fee schedules are not taught by O'Neil et al. or Goldhaber et al., either alone or in combination. Accordingly, the rejection of claims 9, 20, 29, 38, 43, 44, 64, 72, 80, 88, 89, 92 and 99-101 is improper for at least these additional reasons, and Applicants request that the rejection of these claims be withdrawn and the claims allowed.

Claims 10, 11, 21, 22, 30, 31, 39, 40, 90, 91, 93, 94 and 101-103 contain recitations similar to claims 43, 44, 89 and 92, e.g., that the declining fee schedule is reset when, or declines until, the user updates or verifies the information. As argued above, such recitations are neither addressed in the rejection, nor taught by O'Neil et al. or Goldhaber et al. Accordingly, the rejection of claims 10, 11, 21, 22, 30, 31, 39, 40, 90, 91, 93, 94 and 101-103 is improper for at least these additional reasons, and Applicants request that the rejection of these claims be withdrawn and the claims allowed.

Claims 45, 46, 48, 49, 51, 52, 54 and 55 set forth particular incentives offered to users. Claims 47, 50, 53 and 56 recite that the incentive is different than a licensing fee paid to users. The Examiner dismisses these recitations as "not functionally involved in the steps recited," again relying on *Gulack* and *Lowry*. However, as argued above, the Examiner has misapplied these cases. The cited "printed matter" cases are simply not relevant to Applicants' claims, which are drawn to systems, methods and computer readable medium. Further, contrary to the Examiner's assertion, the claim recitations at issue are "functionally involved in the steps recited." For instance, the claim recitations that the incentive "is different than the licensing fees," results in a functionally different

system or method. Consequently, such recitations are to be given patentable weight. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Further, the Examiner alleges that Goldhaber et al. teaches the recitations of claims 58-63, 66-71, 74-79 and 82-87. However, the Examiner has provided no statement as to why one of ordinary skill would modify O'Neil et al. as allegedly taught by Goldhaber et al. Although the rejection previously alleges that "[i]t would have been obvious ... to modify O'Neil et al. to include that the user provides personal information in response to an incentive offered to him," such statement of motivation is unrelated to the features recited by these claims and allegedly taught by Goldhaber et al. Accordingly, the rejection of claims 58-63, 66-71, 74-79 and 82-87 is improper and Applicants respectfully request that, for at least these additional reasons, the rejection be withdrawn and the claims allowed.

Claims 60, 68, 76, 84, 107, 110 and 113 contain recitations similar to claims 95-98. As argued above, claims 95-98 are distinguished from O'Neil et al. and Goldhaber et al., taken alone or in view of each other. Accordingly, for at least these additional reasons, the rejection of claims 60, 68, 76, 84, 107, 110 and 113 should be withdrawn and the claims allowed.

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5. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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